

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) **BA-0333			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10/067,442	Filed February 4, 2002			
	First Named Inventor Todd M. Lynton				
	Art Unit 3629	Examiner Michael J. Fisher			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 36,697</p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top; padding-bottom: 10px; border-left: 1px solid black;"><p style="text-align: center;">/Wendy A. Choi/</p><p style="text-align: center;">Signature</p><p style="text-align: center;">Wendy A. Choi</p><p style="text-align: center;">Typed or printed name</p><p style="text-align: center;">404.459.5642</p><p style="text-align: center;">Telephone number</p><p style="text-align: center;">March 18, 2008</p><p style="text-align: center;">Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 36,697</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p style="text-align: center;">/Wendy A. Choi/</p> <p style="text-align: center;">Signature</p> <p style="text-align: center;">Wendy A. Choi</p> <p style="text-align: center;">Typed or printed name</p> <p style="text-align: center;">404.459.5642</p> <p style="text-align: center;">Telephone number</p> <p style="text-align: center;">March 18, 2008</p> <p style="text-align: center;">Date</p>
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<input type="checkbox"/> *Total of _____ forms are submitted.					

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Todd M. Lynton

Confirmation No.: **7358**

Application No.: **10/067,442**

Group Art Unit: **3629**

Filing Date: **February 4, 2002**

Examiner: **Michael J. Fisher**

For: **Product Registration System**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Request for Pre-Appeal Brief Conference

Applicant requests review of the Final Rejection of January 10, 2008 (FR), by way of a Pre-Appeal Brief Conference. A Notice of Appeal is filed concurrently with this request.

Claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over US-B-6,823,526 (Howard).

The claims under review require, *inter alia*, that a device be registered with a manufacturer of the device in response to a registration request message wherein the registration request message does not include information identifying the user. Howard describes a method where an external device such as a printer is automatically configured when the printer is connected to a host system. *Id.*, column 2, line 64 to column 3, line 40. Howard states:

By receiving a device identification string or "device idstring," the host system 20 recognizes that the external device 30 is integrated with the host system 20 so that the external device 30 may properly receive instructions and applications from the host system 20. An example of a device idstring having data fields for a Hewlett-Packard LASERJET2200 laser printer is illustrated in FIG. 3. Accordingly, as discussed in detail below, the external device 30 provides a device idstring.

Id., column 4, lines 15 to 22. As seen, Howard is providing a way of “installing” an external device such as a printer to a computer system, not sending a registration request message to a manufacturer wherein the registration request message does not include information identifying the user.

The Examiner understands that Howard does not describe “registering the device with the manufacturer.” FR, pages 2 to 3. To make up for this deficiency the Examiner relies upon column 7, lines 36 to 40 of Howard. The paragraph that contains this passage reads:

As the system 10 is initially connecting with the host system 20 and the external device 30, the host system 20 runs the installer 22. The installer 22 is an executable installation program that is associated with the external device 30. The installer 22 installs software components in the operating system 29 of the host system 20. In general, the installer 22 installs software components for enabling the host system 20 to operate the external device 30. The installer 22 installs at least one device driver 26 as well as other device utilities, such as for example a font management utility or a status monitor. The installer 22 may also interactively provide the user with merchandising information associated with the external device 30, such as verification of warranty registration and software license agreements.

The Examiner states “[a]s its status is checked, it would have been obvious...to provide a mechanism for registering the warranty in case it has not been registered yet.” FR, page 3.

Missing from the Examiner’s analysis is an explanation as to how “verification of warranty registration” by installer 22 of Howard means that the device would be registered with the manufacturer without including information identifying the user as required by the present claims. Howard provides no details as to how that function would occur and warranty registration with the manufacturer typically includes the submission of information identifying the user. See, *e.g.*, specification, paragraph [0011] which reads:

[0011] When a consumer purchases a computing product, such as a computer, printer, modem, or software package, it is often necessary or desirable for the consumer to register the product with the product's manufacturer before the first use of the product. Registration of such a product typically requires the product owner to provide personal identifying information--such as the owner's name, address, and telephone number--on a printed form that is

mailed or faxed to the manufacturer, or on a web-based form that is transmitted to the manufacturer over the World Wide Web. Similarly, users are typically required to register with online services, such as web-based services for purchasing event tickets, downloading electronic coupons, or storing digital photographs in online albums, before first using such services. Such registration processes typically require the user to provide personal identifying information similar to that required for product registrations.

The lack of an explanation as to how Howard teaches this aspect of the claimed subject matter is error since obviousness under 35 U.S.C. § 103(a) exists only when the subject matter of a claim as a whole would have been obvious.

In responding to this argument, the Examiner stated in the Final Rejection “the examiner has pointed out exactly where this is located in the prior art, as applicant has not argued against what the examiner wrote, merely denying that it is in the prior art.” FR, pages 4 to 5. With all due respect, the Final Rejection does not point out where Howard teaches the device would be registered with the manufacturer without including information identifying the user as required by the present claims. All the Examiner has asserted is that Howard does not teach “registering the device with the manufacturer” and “[a]s its status is checked, it would have been obvious...to provide a mechanism for registering the warranty in case it has not been registered yet.” FR, page 3. While the Examiner also asserts that Howard registers the external device “using only the identification of the machine not the owner,” FR, page 2, this registration is an internal registration within the host system and not an external registration with the manufacturer of the device as required by the claims under review. Thus, the Examiner has not “pointed out exactly where this is located in the prior art.”

Howard provides no details as to how installer 22 would provide verification of warranty registration, let alone without including information identifying the user. Viewing Howard by itself without knowledge of the present application and claims as required by 35 U.S.C. § 103(a), it is seen that the Examiner’s rejection is based upon impermissible hindsight. Appellant should not be forced to bear the expense of an Appeal Brief under these circumstances.

Accordingly, applicant respectfully requests reconsideration and withdrawal of the final rejections of claims 1 to 8, 10, 12 to 19, 21, 23 to 28, 30 to 38, 42 to 49, 51, 53 to 58, and 60 to 72 under 35 U.S.C. § 103(a).

Respectfully submitted,

Date: **March 18, 2008**

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